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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,108	06/15/2006	Ross Manton Hutchens	MDR-00001	1235
7590	12/31/2008		EXAMINER	
Warn Hoffmann Miller and LaLone 691 North Squirrel Road Suite 140 Auburn Hills, MI 48326			MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
			3679	
			MAIL DATE	DELIVERY MODE
			12/31/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/583,108	HUTCHENS, ROSS MANTON	
	<b>Examiner</b>	<b>Art Unit</b>	
	VICTOR MACARTHUR	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 June 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>8/18/2006</u>	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “configurations” (line 10 of claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in

the claims must be described in the written description with reference characters regarding the drawings; or those features must be deleted from the claims, i.e., “configurations” (line 10 of claim 9).

### ***Claim Objections***

Claims 9-13 are objected to because of the following informalities:

- The phrase(s) “configurations” (line 10 of claim 9) are not recited in the specification. Furthermore, it is unclear which drawing elements, if any, are represented by the above-mentioned phrases.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. Take for instance the following examples:

- The term “drive means” (line 11 of claim 1) lacks function. Furthermore, the phrase is not a proper means-plus-function limitation since it is further limited by structure

(e.g., “said drive means including a driven worm gear” in lines 14-15 of claim 1).

Accordingly, it is unclear if the phraseology invokes 112 6<sup>th</sup> paragraph or not.

- It is unclear if the phrase “translated into linear motion only of the shaft” (last line of claim 1) limits the shaft to have no other motion than linear motion; or limits the shaft to be the only claimed element capable of linear motion (of all claimed elements).
- It is unclear whether the phrase “configurations” (line 10 of claim 9) refers structural elements in addition to previously recited elements; or to specific positionings of previously recited elements.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the claim scope. The applicant is strongly urged to amend the claims to conform to current U.S. practice.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 7, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Giovannetti (U.S. Patent 4,343,566).

The prior art appears to disclose all of the applicant's claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2<sup>nd</sup> paragraph rejections above).

The prior art discloses applicant's claimed joiner structure to include a rack portion (40) and worm gear (47) and worm gear actuator (45').

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Migli (US 20050042027 A1).

The figures of Migli set forth a joiner similar to applicant's claims but having a rotatable drum rather than a rack and pinion as claimed. Migli specifically states "Although the preferred locking element for many application is in the form of a rotatable drum, it will be understood that such a locking element is not limited to a rotatable drum but may [use] a rack and pinion type adjuster [instead]" (para.0099).

- The examiner takes **OFFICIAL NOTICE** that rack and pinion assemblies, such as those suggested by Migli, are extremely well known in the art to comprise applicants claimed rack and pinion details recited in the claims.
- Furthermore, combining the joiner art of Migli with what is known in the rack and pinion art (as officially noticed above) would not result in any synergistic, contrary or

otherwise unexpected result. Accordingly, the combination of the Migli joiner art and the officially noticed rack and pinion art, is at best an ordinary innovation, since the results of such a combination would be predictable from what was known about the arts separately. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Migli joiner to include a rack and pinion structure as noted above, since such combination is specifically suggested by Migli, and further since doing so produces results that are entirely predictable from what is known about the separate arts.

Claims 1, 4, 5, 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallance (U.S. Patent 5567081).

The figures of Vallance set forth a joiner similar to applicant’s claims but having a rotary cam rather than a rack and pinion as claimed. Migli specifically states “the adjusting means is not limited to a rotary cam means but... It is also envisaged that a rack and pinion type adjustor would be applicable to the device” (col.10, ll.50-56).

- The examiner takes **OFFICIAL NOTICE** that rack and pinion assemblies, such as those suggested by Vallance, are extremely well known in the art to comprise applicants claimed rack and pinion details recited in the claims.

- Furthermore, combining the joiner art of Vallance with what is known in the rack and pinion art (as officially noticed above) would not result in any synergistic, contrary or otherwise unexpected result. Accordingly, the combination of the Vallance joiner art and the officially noticed rack and pinion art, is at best an **ordinary innovation**, since the results of such a combination would be predictable from what was known about the arts separately. “[T]he results of **ordinary innovation** are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Vallance joiner to include a rack and pinion structure as noted above, since such combination is specifically suggested by Vallance, and further since doing so produces results that are entirely predictable from what is known about the separate arts.

Lastly, the examiner would like to point out that it would be a misconception to believe that all innovation is patentable. In fact, the Supreme Court has consistently held (see bullet statements below) that **ordinary** innovation is not patentable. That is to say, when all of the pieces of applicant’s claimed product structure are present in separate prior art documents, combining those pieces would be **ordinary** innovation, at best, and thus unpatentable unless applicant can show some result that would be contrary, synergistic or otherwise unpredictable from what was known about the prior art pieces separately. As an example let us pretend for the sake of argument that the Seiji document consisted solely of pictures and thus did not give

specific written motivation to replace a one-piece ball and stud with a two-piece ball and stud. In such a case the applicant would still have the burden of showing some unexpected result from replacing the Dorr one-piece assembly with the Seiji two-piece assembly. Without any such unexpected, unpredictable result, the combination would be an ordinary innovation, at best, and thus obvious and unpatentable as a mere common sense design choice. Of course, this scenario is moot since Seiji in fact gives very specific motivation as is detailed in the rejections and response to arguments above. However, the examiner presents this hypothetical situation as a preface to a request to the Board. I respectfully request that the Board take pause prior to suggesting any allowable amendment to the claims. Please note that the art used in the final rejection (Dorr and Seiji) are the most applicable to the claims as currently written. No amendment should be suggested without first considering the entirety of the ball joint arts, not just those documents cited to pertain to the claims as currently written. For instance, the examiner notes that claim 65 could be amended to overcome Dorr by replace “a semispherical space” with --a space defined and bounded between a cylindrical inner surface of the receptacle and spherical outer surface of the ball joint--. However, such defined spaces are well known in the ball joint art to be completely occupied by bearings (figure 4 of Seiji for example) and there is no synergistic, contrary, or otherwise unexpected result that would not be predictable from what was known about the art pieces separately.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

December 31, 2008

/Victor MacArthur/  
Primary Examiner, Art Unit 3679